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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,411	11/03/2000	Michael Nowak	Y2K.0090	6773

7590 02/27/2002

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EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/705,411

Applicant(s)

NOWAK, MICHAEL

Examiner

James M Hewitt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/2/01 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

The drawings are objected to because the short tabs 130 are not clearly shown; short tabs 130 should be shown in figures 3 and 4; low tag area 136 should be shown in figure 5; in figure 5, plate 154 points to the apertures and not the plate. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 146. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

130 → 2 diff. parts

### *Claim Objections*

✓ Claim 1 is objected to because of the following informalities: in claim 1 line 3, delete "the advertising device including". Appropriate correction is required.

✓ Throughout the dependent claims, should the phrase "further comprising" in the preamble instead be "wherein"? This seems to allow the claims to read easier. The phrase "further comprising" is used to introduce new elements. No new elements are being introduced in said claims, existing elements are just further defined or described.

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frame + ad device  
same?

### **Double Patenting**

Applicant is advised that should claims 3-4 and 9-10 be found allowable, claims 5-6 and 11-12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

X In claim 2 lines 2 and 4, "the frame" should be replaced with "the advertising device". This rejection also applies to claim 8.

X In claim 2 lines 8-10, the phrase "the at least one slit...relative to the frame" is awkward and confusing. This rejection also applies to claim 8.

X In claim 3 lines 2-4, the phrase "the frame...at least one tab" is awkward and confusing. This rejection also applies to claim 5 and claims 9 and 11.

X In claim 7, it is unclear how "the at least one advertisement" relates to "the advertising device".

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✓ In claim 8 line 1, should the preamble instead read "The vehicle of claim 7 further comprising"?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Ipsen (US 5,487,568).

Ipsen discloses an advertising device adapted for mounting on a vehicle, the device comprising a frame (16/17) and a center section (15); the device being adapted for securing to a license plate area of a vehicle; the frame being securable to the vehicle; the frame and the center section being adapted to have advertising thereon; and the frame being separable from the center section.

With respect to claim 2, wherein the frame has at least one slit (of perforation 28) separating the center portion from the frame; the frame having at least one tab (of perforation 28) connecting the center portion to the frame; the at least one tab being adapted for severing the center portion from the frame.

With respect to claim 3, wherein the tab facilitates separation of the center portion from the frame; the frame including at least one aperture (see figures 7-9, the top strip of the frame includes a row of apertures).

With respect to claim 4, wherein the device is generally rectangular.

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With respect to claims 5 and 6, refer to the rejections of claims 3 and 4.

With respect to claims 7-12, refer to the above rejections of claims 1-4.

With respect to claims 1-12, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

It has also been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597/8 for regular communications and 703-308-3687 for After Final communications.

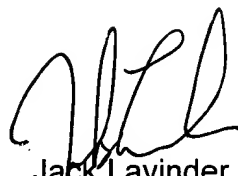
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.

*jmh*

jmh

February 15, 2002

 2/25/02  
Jack Lavinder  
Supervisory Examiner  
G.A.U. 3628